

REMARKSRestriction Requirement

Restriction is proper only if the restricted claims are independent or patentably distinct and there is no serious burden placed on the Examiner if restriction is not required (MPEP §803). The burden is on the Examiner to provide reasons and/or examples to support any conclusion of patentable distinctness between the restricted claims (MPEP §803). Applicant respectfully traverses the restriction requirement on the grounds that the Office has not carried the burden of providing any reason and/or example to support the conclusion that the claims of the restricted groups are, in fact, distinct. Applicant further traverses the restriction requirement because there is clearly no additional burden on the Office if the restriction requirement is not made.

The Office has characterized the relationship between Groups I and II as product and process of use. Citing MPEP §806.05(h), the Examiner states that claims in this relationship can be shown to be distinct if either of the following can be shown: (1) that the process for using the product as claimed can be practiced with another and materially different product; or (2) that the product as claimed can be used in a materially different process of using that product. The Examiner goes on to state that, in the present application, the method of Claim 11 could be practiced by Western Blot analysis of protein-protein interaction over time. However, Applicants submit that the reason offered by the Examiner is insufficient to support a conclusion of patentable distinctness between the restricted claims. The Examiner has provided no indication as to the feasibility of practicing the recited method by Western Blot analysis without using the elements recited in the claims of Group I. Nor has the Office made any attempt to demonstrate how practicing the method by Western Blot analysis can be accomplished using another materially different product. In other words, the Office has provided no sound scientific rationale that the process can be practiced using a materially different product than that recited in the claims of Group I.

Applicants respectfully note that the statement at page 2, lines 16-18 of the Office Action that, "In the instant case, one could practice the method,...via a materially different product," is simply a restatement of the conclusion of patentable distinctness.

Additionally, Applicants note that because the method of Group II explicitly requires using the polypeptides of Group I, the search of Claim 11 (Group II) will necessarily encompass a search for polypeptides polypeptides of Group I. Thus, Applicants submit that there is no additional burden on the Office if restriction is not required. On this point, the Examiner's attention is directed to MPEP §803.02:

If the members of the Markush groups are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions. In such a case the, examiner will not follow the procedure described below and will not require restriction.

For the above-stated reasons, Applicants traverse the restriction requirement and hereby request that it now be withdrawn.

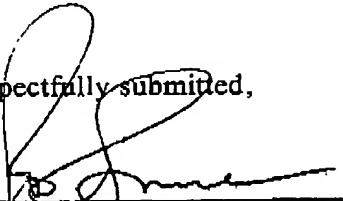
Election of Species

In the same fashion as a restriction requirement, an election of species requirement is proper only if the restricted species are independent or patentably distinct and there is no serious burden placed on the Office if an election is not required (MPEP §803). The burden is on the Office to provide reasons and/or examples to support any conclusion of patentable distinctness between the restricted species (MPEP §803). Applicant respectfully traverses the election of species requirement on the grounds that the Office has not carried the burden of providing any reason and/or example to support the conclusion that the species are, in fact, distinct.

Additionally, the Office has provided no reasons or examples to support the conclusion of patentable distinctness between the species recited in these claims. It is insufficient for the Office merely to identify mutually exclusive moieties and state that they are patentably distinct on that basis alone. The Office must supply some reason and/or examples to support the conclusion of patentable distinctness between the restricted species. Therefore, Applicants submit that the required election of species is improper. Applicants thus respectfully request the election of species requirement be withdrawn.

Applicants submit that the application is now ready for examination on the merits.
Early notification of such action is earnestly solicited.

Respectfully submitted,


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